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Filed : March 2, 2004

### REMARKS

By way of summary, Claims 1-31 were originally filed in the present application. Claims 32-36 were added by previous amendment. Claims 6, 8, 12, and 15 have been amended herein. Claims 7 and 11 have been canceled herein. Claim 37 has been added herein. Accordingly, Claims 1-6, 8-10, and 12-37 are pending.

Amendments to the claims set forth above include markings to show the changes by way of the present amendment, deletions being in ~~strikeout~~ (e.g., ~~strikeout~~) and additions being underlined (e.g., underlined).

#### Claims 1-4, 6-12, 15-21, 31-32, and 34 are allowable over Seto

Claims 1-4, 6-12, 15-21, 31-32, and 34 stand rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,533,060 issued to Seto. In view of the following discussion, Applicants respectfully traverse the rejections.

#### Claims 1-4 and 34

Claim 1 recites:

An off-road vehicle comprising a frame, a plurality of wheels arranged to support the frame, an internal combustion engine powering at least one of the wheels, and an air intake system arranged to supply air to the engine for combustion, the air intake system having an air inlet through which ambient air enters the intake system, the air inlet positioned higher than an uppermost surface of the wheels, and an air intake duct extending rearward to the engine, at least a portion of the air intake duct being positioned lower than the uppermost surface of the wheels.

Seto does not disclose each and every limitation of Claim 1. In contrast to Claim 1, Seto discloses, among other recited elements, an intake pipe 96 that extends forwardly to an engine 36. Col. 6, lines 28-30. Figure 1 of Seto illustrates the intake pipe 96 extending forwardly from a carburetor 94 to a cylinder head 80 of the engine 36. Thus, because Seto does not disclose all the limitations of Claim 1, Applicants respectfully submit that Claim 1 is patentably distinguished over Seto.

Dependant Claims 2-4 and 34 are patentably distinguished over Seto for at least the reasons with respect to Claim 1 as well as for novel and nonobvious features recited therein. Thus, Claims 1-4 and 34 are in condition for allowance.

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Claim 6-12 and 15-21

Claim 6 has been amended to incorporate the limitations of Claims 7 and 11, which have been canceled. Amended Claim 6 recites:

An off-road vehicle comprising a frame, a plurality of wheels arranged to support the frame, a hood configured to cover at least a first portion of the frame, an internal combustion engine powering at least one of the wheels, an air intake system arranged to supply air to the engine for combustion, the air intake system comprising an air cleaner configured to clean the air and an air delivery conduit arranged to deliver the air in the air cleaner to the engine, the air cleaner disposed below a central portion of the hood, the engine being disposed on a second portion of the frame, the second portion being spaced apart from the first portion, a third portion of the frame extending between the first and second portions, the third portion including a floorboard, and at least a portion of the air delivery conduit extending below the floorboard.

Seto does not disclose all the limitations of amended Claim 6. For example, Seto does not disclose, among other things, that a third portion of the frame extends between the first and second portions, the third portion includes a floorboard, and at least a portion of the air delivery conduit extends below the floorboard. Therefore, Applicants respectfully submit that Claim 6 is patentably distinguished over Seto.

Dependant Claims 8-10, 12 and 15-21 are patentably distinguished over Seto for at least the reasons with respect to Claim 6 as well as for novel and nonobvious features recited therein. Thus, Claims 6, 8-10, 12, and 15-21 are in condition for allowance.

Claims 31 and 32

Claim 31 recites:

An off-road vehicle comprising a frame, a plurality of wheels arranged to support the frame, at least one seat supported by the frame, an internal combustion engine powering at least one of the wheels, and an air intake system arranged to supply air to the engine for combustion, the air intake system comprising an air cleaner configured to filter the air, the seat being disposed in a fore to aft direction on the vehicle such that the air cleaner lies forward of the seat and at least a portion of the engine lies to the rear of the seat.

Seto does not disclose all the limitations of Claim 31. In contrast to Claim 31, Seto discloses, inter alia, an engine 36 positioned below and forward of the seat 52. See, e.g., Figure 1

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of Seto. Therefore, Applicants respectfully submit that Claim 31 is patentably distinguished over Seto.

Dependant Claim 32 is patentably distinguished over Seto for at least the reasons with respect to Claim 31 as well as for additional novel and nonobvious features recited therein. Thus, Claims 31 and 32 are in condition for allowance.

**Cited References Do Not Render Claims 5, 13, 14, 22-30, 33, 35, and 36 Obvious**

Claims 5, 13, 14, 22-30, 33, 35, and 36 stand rejected under 35 U.S.C. § 103 as unpatentable over Seto in view of U.S. Patent No. 6,582,004 issued to Hamm. For the following reasons, Applicants respectfully submit that the claims are in condition for allowance.

**Claims 5, 13, 14, and 33**

Dependent Claims 5, 13, 14, and 33 are allowable as depending from allowable base claims, as well as for novel and non-obvious combination of elements recited therein. For example, Claim 5 recites at least two seat assemblies disposed side by side on the frame, the air inlet positioned between the seat assemblies in a top plan view of the vehicle. Seto and Hamm, either individually or in combination, do not teach or suggest the unique combination of limitations recited by Claim 5. These dependent claims thus are allowable on their own merit.

**Claims 22-30, 35, and 36**

Claim 22 recites:

An off-road vehicle comprising a frame, a plurality of wheels arranged to support the frame, at least two seat assemblies disposed side by side on the frame, an internal combustion engine powering at least one of the wheels, and an air intake system arranged to supply air to the engine for combustion, the air intake system comprising an air cleaner configured to clean the air, at least a portion of the air cleaner is positioned between the seat assemblies.

Applicant respectfully submits that the present rejections also do not establish a *prima facie* case of obviousness under 35 U.S.C. §103(a). The prior art references must also teach or suggest all the claim limitations. The Examiner must also show some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the teaching.

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Seton and Hamm, either individually or in combination, do not teach or suggest the unique combination of limitations recited by Claim 22. For example, Seto does not teach or suggest, inter alia, that the air intake system is arranged to supply air to the engine for combustion and at least a portion of the air cleaner is positioned between the seat assemblies. Seto teaches having a single seat 52. Thus, Seto does not disclose that at least a portion of the air cleaner is positioned between the seat assemblies.

Hamm does not teach or suggest the deficiencies of Seto. Hamm does not teach or suggest, among other things, having an air cleaner at any particular location, let alone the air cleaner positioned between the seat assemblies. Thus, Seton and Hamm, either individually or in combination, do not teach or suggest the unique combination of limitations recited by Claim 22.

Additionally, the Examiner must show some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, for the asserted modification. The Examiner modifies the Seto all terrain vehicle ("ATV") with the seats of Hamm for the Examiner's asserted purpose of carrying an additional person. *Office Action*, pages 6 and 7. However, Seto teaches having a single rider straddling the seat 52 with a leg positioned to either side of the seat 52 and with each foot resting on an associated foot rest 58. Col. 4, lines 60-62. These types of seats are typically not suitable for a side-by-side seat arrangement as taught by Hamm. Furthermore, Hamm teaches utilizing non-straddle type seats 34. The differences between the seats of Seto and Hamm would deter one of ordinary skill away from modifying Seto as asserted by the Examiner. Thus, Claim 22 is in condition for allowance.

Dependant Claims 23-30, 35, and 36 are patentably distinguished over the cited references for at least the reasons with respect to Claim 22 as well as for novel and nonobvious features recited therein. Thus, Claims 22-30, 35, and 36 are in condition for allowance.

#### New Claims

Claim 37 have been added. This claim is fully supported by the application as filed. Accordingly, no new matter has been added by this amendment. Additionally, Claim 37 partakes of the novel features of Claim 31 for which it depends and, thus, is allowable for at least the same reasons recited above. Consideration of new Claim 37 is respectfully requested.

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**Conclusion**

For the foregoing reasons, it is respectfully submitted that the rejections set forth in the outstanding Office Action are inapplicable to the present claims. Accordingly, early issuance of a Notice of Allowance is most earnestly solicited.

Any remarks in support of patentability of one claim should not be imputed to any other claim, even if similar terminology is used. Any remarks referring to only a portion of a claim should not be understood to base patentability on solely that portion; rather, patentability must rest on each claim taken as a whole.

The undersigned has made a good faith effort to respond to all of the rejections in the case and to place the claims in condition for immediate allowance. Nevertheless, if any undeveloped issues remain or if any issues require clarification, the Examiner is respectfully requested to call Applicants' attorney in order to resolve such issue promptly.

Respectfully submitted,

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